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EXAMINER

PARK, CHAN S

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2625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/718,179	Applicant(s) TALLEY ET AL.	
	Examiner CHAN S. PARK	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TRAN
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims are objected to because of the following informalities:

Claim 1, line 2, "a printed page" should be -- the printed page --;

Claim 15, lines 5 and 7, "multifunction printer" should be -- the multifunction printer --;

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8, 10-14, 16-18 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ericson U.S. Patent Application Pub. No. 2002/0054778 in view of Garland et al. U.S. Patent No. 5,544,045 (hereinafter Garland).

2. With respect to claim 1, Ericson teaches a method of editing a printed page, comprising:

scanning the printed page, the printed page including text and at least one handwritten edit symbol (paragraphs 68-69 & fig. 5a);

obtaining a first electronic printable file, which corresponds to the text, and at least one electronic edit symbol, which corresponds to the at least one handwritten edit symbol (paragraphs 68-71 & fig. 5a); and

electronically modifying, via the multifunction printer, the first electronic printable file with at least one electronic edit instruction, which corresponds to the at least one electronic edit symbol, to create a second electronic printable file that includes the text modified according to the at least one handwritten edit symbol (paragraphs 72-76).

Ericson, however, does not explicitly teach that each steps are performed by/via a multifunction printer.

Garland, the same field of endeavor of the document editing art, teaches the method reading/editing/printing document via a multifunction printer (abstract & col. 2, lines 1-55).

At the time of invention, it would have been obvious to one of ordinary skill in the art to implement the document editing method of Ericson into the multifunction printer of Garland.

The suggestion/motivation for doing so would have been to provide the capability of editing document using the handwritten editing symbol via a single multifunction device.

Therefore, it would have been obvious to combine Ericson with Garland to obtain the invention as specified in claim 1.

3. With respect to claim 2, the combination teaches the method of claim 1 wherein electrically modifying the first electronic printable file comprises:

using a computer in communication with, and cooperation with, the multifunction printer to electronically modify the first electronic printable file (paragraph 74 of Ericson & fig. 2 of Garland).

4. With respect to claim 3, the combination teaches the method of claim 2 and further comprising:

performing, via at least one of the multifunction printer and the computer, at least one of printing the second electronic printable file at least one of the multifunction printer (col. 2, lines 38-43 of Garland) and a second printer (paragraph 79 of Ericson), digitally sending the second electronic printable file to a recipient (paragraph 79 of Ericson), storing the second electronic printable file in a memory (paragraphs 79-81 of Ericson), and sending the second electronic printable file to a memory location external of the computer and the multifunction printer (paragraphs 79-81 of Ericson). Note that it would have been obvious to one of ordinary skill in the art to distribute and print the edited document at any available printer after reviewing the document.

5. With respect to claim 4, the combination teaches the method of claim 2 wherein obtaining the first electronic printable file comprises:

obtaining a digital image file of the printed page by scanning the printed page with a scanner of the multifunction printer and optically recognizing the digital image file, via at least one of the multifunction printer and the computer, for conversion to the first electronic printable file (col. 1, lines 56-67 of Garland & paragraphs 72, 73 & 80 of Ericson).

6. With respect to claim 5, the combination teaches the method of claim 4 wherein electronically modifying the first electronic printable file comprises at least one of modifying a page description file and modifying a text editable file (col. 2, lines 1-43 of Garland & paragraph 73 of Ericson).

7. With respect to claim 8, the combination teaches the method of claim 2 wherein obtaining the electronic edit symbol via the multifunction printer comprises:

optically recognizing the handwritten edit symbol as the electronic edit symbol from a first array of electronic edit symbols stored in a memory of the multifunction printer (fig. 1 of Garland & paragraphs 73, 74 & 76 of Ericson); and

wherein electronically modifying the first electronic printable file comprises:

retrieving the at least one electronic edit instruction from a second edit symbol array stored in the computer (paragraphs 80-81 of Ericson); and

applying, at the computer, the at least one electronic edit instruction to the first electronic printable file (paragraphs 80-81 of Ericson).

8. With respect to claim 10, the combination teaches the method of claim 1 wherein obtaining the electronic edit symbol via the multifunction printer comprises:

optically recognizing the at least one handwritten edit symbol as the electronic edit symbol from an array of electronic edit symbols stored in a memory of the multifunction printer (paragraphs 73-74 of Ericson); and

wherein electronically modifying the first electronic printable file via the multifunction printer comprises:

retrieving the at least one electronic edit instruction from the edit symbol array and applying, at the multifunction printer, the at least one electronic edit instruction to the first electronic printable file (col. 2, lines 1-43 of Garland & paragraphs 73-74 of Ericson).

9. With respect to claim 11, the arguments are analogous to those presented for claim 1, are applicable.

10. With respect to claim 12, the combination teaches the method comprising:

performing at least one of printing the revised electronic document (paragraphs 80-81 of Ericson & col. 2, lines 30-43 of Garland), digitally sending the revised electronic document to a recipient, storing the revised electronic document in a memory of the multifunction printer, and sending the revised electronic document to a memory location external of the multifunction printer.

11. With respect to claim 13, Ericson discloses a device comprising:

a memory (a memory storing the scanned text either permanently or temporarily in paragraph 68-72);

a scanner configured for obtaining an electronic image file of at least one printed page that includes a text and at least one handwritten symbol and for storing the electronic image file in the memory (fig. 5b);

an optical recognition function configured to perform an optical character recognition on the electronic image file to recognize the at least one handwritten edit symbol as an electronic edit symbol (fig. 5c), and configured to obtain a first electronic printable file corresponding to the text of the at least one printed page (paragraph 73);

an edit manager stored in the memory and configured, in communication with the optical recognition function, to apply an electronic edit instruction corresponding to the electronic edit symbol to the first electronic printable file to create a second electronic printable file that includes the text modified according to the at least one handwritten edit symbol (paragraph 73).

Ericson, however, does not explicitly teach that each steps are performed by/via a multifunction printer.

Garland, the same field of endeavor of the document editing art, teaches the method reading/editing/printing document via a multifunction printer (abstract & col. 2, lines 1-55).

At the time of invention, it would have been obvious to one of ordinary skill in the art to implement the document editing method of Ericson into the multifunction printer of Garland.

The suggestion/motivation for doing so would have been to provide the capability of editing document using the handwritten editing symbol via a single multifunction device.

Therefore, it would have been obvious to combine Ericson with Garland to obtain the invention as specified in claim 13.

12. With respect to claim 14, the combination discloses the multifunction printer of claim 13 wherein the optical character recognition function is further configured to optically recognizing at least one of:

the text of the at least one printed page from the electronic image file as the first electronic printable file (paragraph 73 of Ericson); and

an electronic identifier of the at least one printed page from the electronic image file for use as a memory pointer that points to an external memory location and retrieving the first electronic printable file from that external memory location; and

an electronic identifier of the at least one printed page from the electronic image file for use as a memory storage that stores the first electronic printable file and retrieving the first electronic printable file from that memory storage.

13. With respect to claim 16, the combination discloses the multifunction printer of claim 13 wherein the edit manager comprises:

an edit symbol array including:

a plurality of electronic edit symbols with each electronic edit symbol uniquely corresponding to a handwritten edit symbol (figs. 5a & 5c of Ericson); and

a plurality of electronic edit instructions with each electronic edit symbol corresponding uniquely to one of the electronic edit instructions (figs. 5a & 5c of Ericson).

14. With respect to claim 17, the combination teaches the multifunction printer of claim 16 wherein the edit manager comprises:

an edit rules library configured to support application of the electronic editing instructions of the edit symbol array and including at least one of a grammar function, a dictionary function, and a format function (paragraph 76 of Ericson). Note that the

conventional proof reading includes a dictionary function and a grammar function.

Therefore, it would have been obvious to one of ordinary skill in the art to include such function symbols in the combined system of Ericson and Garland.

15. With respect to claim 18, the combination discloses the multifunction printer of claim 13 wherein the optical character recognition function is stored in at least one of the memory of the multifunction printer, a controller of the multifunction printer, and an application specific integrated circuit (paragraphs 73 & 74).

16. With respect to claim 20, Ericson discloses a device comprising:

means for obtaining an electronic printable file corresponding to at least one printed page that includes a text and at least one handwritten edit symbol (fig. 5a);

means for applying an electronic edit instruction, corresponding to the at least one handwritten edit symbol, to modify the electronic printable file (paragraph 73); and

means for communicating the modified electronic printable file as at least one of a modified printed page, a digitally sent file, and a file configured for storage at least one of the device (paragraph 73) and a location external of the multifunction printer (paragraphs 80-81).

Ericson, however, does not explicitly teach that each steps are performed by/via a multifunction printer.

Garland, the same field of endeavor of the document editing art, teaches the method reading/editing/printing document via a multifunction printer (abstract & col. 2, lines 1-55).

At the time of invention, it would have been obvious to one of ordinary skill in the art to implement the document editing method of Ericson into the multifunction printer of Garland.

The suggestion/motivation for doing so would have been to provide the capability of editing document using the handwritten editing symbol via a single multifunction device.

Therefore, it would have been obvious to combine Ericson with Garland to obtain the invention as specified in claim 20.

17. With respect to claim 21, the combination discloses the multifunction printer of claim 20 and further comprising:

means external of the multifunction printer for storing and for activating the means for applying the electronic edit instruction (paragraphs 80-81 of Ericson).

18. With respect to claim 22, the combination discloses the multifunction printer of claim 21 wherein the means external of the multifunction printer comprise a computer in communication with the multifunction printer (paragraphs 80-81 of Ericson).

Claims 6, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ericson and Garland as applied to claims 1 and 2 above, and further in view of Yano et al. U.S. Patent No. 6,910,184 (hereinafter Yano).

19. With respect to claim 6, the combination teaches the method of claim 2 (particularly, refer to paragraph 82 of Ericson), but it does not explicitly teach the method of optically recognizing, via the multifunction printer, an electronic identifier of

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the printed page as an electronic memory pointer and, based on the electronic memory pointer, retrieving the first electronic printable file from a memory available at a uniform resource locator address.

Yano, the same field of endeavor of optically recognizing printed information via multifunction printer art, teaches the method of optically recognizing, via the multifunction printer, an electronic identifier of the printed page as an electronic memory pointer and, based on the electronic memory pointer, retrieving the first electronic printable file from a memory available at a uniform resource locator address (col. 7, lines 38-64 & col. 8, lines 21-60).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the method of retrieving a desired document via a network into the combined editing/printing system of Ericson and Garland.

The suggestion/motivation for doing so would have been to retrieve the network documents for editing and printing using the method taught by Ericson and Garland.

Therefore, it would have been obvious to combine three references to obtain then invention as specified in claim 6.

20. With respect to claim 7, arguments analogous to those presented for claim 6, are applicable. Refer to col. 7, lines 38-64 of Yano for retrieving document using the electronic identifier.

21. With respect to claim 9, arguments analogous to those presented for claim 6, are applicable. However, Yano does not explicitly teach whether the retrieval of the file is done wirelessly. Examiner take an Official Notice that the wireless communication in

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the network printer is well known in the printing art. Therefore, it would have been obvious to one of ordinary skill in the art to implement the wireless communication function in the combined system of three references.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ericson and Garland as applied to claim 13 above, and further in view of Yano.

22. With respect to claim 19, arguments analogous to those presented for claim 9, are applicable.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ericson and Garland as applied to claim 13 above, and further in view of Kanematu U.S. Patent No. 7,130,066 (hereinafter Kanematu).

23. With respect to claim 15, the combination discloses the multifunction printer of claim 13, but it does not explicitly disclose a user interface comprising: an electronic mail function, a print function, a save function, and a send function.

Kanematu, the same field of endeavor of the multifunction printer art, discloses a multifunction printer comprising a user interface comprising:

an electronic mail function configured to permit specifying an electronic mail address to which an electronic printable file will be digitally sent by the multifunction printer (figs. 25 & 53);

a print function configured to permit specifying that the electronic printable file be printed by the multifunction printer (figs. 14~18);

a save function configured to permit specifying that the electronic printable file be saved in the memory of the multifunction printer (figs. 23 (button 363) & 63); and

a send function configured to permit sending the electronic printable file in a memory location external of the multifunction printer (fig. 23).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the user interface of Kanematu into the combined system of Ericson and Garland.

The suggestion/motivation for doing so would have been to provide a plurality of options for managing the second electronic printable file over the network.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claim 15.

Contact Information

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DOUGLAS Q. TRAN
PRIMARY EXAMINER

csp
August 2, 2007

Chan S. Park
Examiner
Art Unit 2625

